



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Leonard T. Schroath et al.

Confirmation No.: 2850

Application No.: 10/002,003

Examiner: Bryce P. Bonzo

Filing Date: 12/05/2001

Group Art Unit: 2114

Title: Method and Apparatus for Rebooting Printer

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 02/03/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

**(complete (a) or (b) as applicable)**

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(X) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

(X) one month	\$120.00	05/09/2005 AHONDAF1 00000020 082025 10002003
( ) two months	\$450.00	
( ) three months	\$1020.00	02 FC:1251 120.00 DA
( ) four months	\$1590.00	

( ) The extension fee has already been filled in this application.

( ) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$620.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. .... 10/002,003  
Filing Date..... December 5, 2001  
Inventor..... Leonard T. Schroath  
Assignee..... Hewlett Packard Company  
Group Art Unit ..... 2114  
Examiner..... Bryce P. Bonzo  
Attorney's Docket No..... PDNO. 10013179-1  
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Title: .....Method and Apparatus for Rebooting a Printer

**BRIEF OF APPELLANT**

To:           Mail Stop Appeal Brief-Patents  
              Commissioner of Patents  
              P.O. Box 1450  
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Appellant appeals from the final rejection, mailed November 4, 2004, of claims 1-12 and 18-22. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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Serial No. : 10/002,003  
Brief of Appellant

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**I. REAL PARTY IN INTEREST**

The real party in interest of this application is Hewlett-Packard Company as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded at Reel 012635, Frames 0015-0016 in the Assignment Branch of the Patent and Trademark Office and full assignment of the pending application to Hewlett-Packard Development Company, L.P. recorded at Reel 014061, Frames 0492-0603 in the Assignment Branch of the Patent and Trademark Office.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF THE CLAIMS**

Claims 1-22 are pending. Claims 13-17 are allowed. Claims 1-12 and 18-22 were finally rejected. The final rejection of claims 1-12 and 18-22 is being appealed.

The Examiner indicated to the undersigned by telephone on April 28, 2005 that the statement in the Advisory Action mailed January 12, 2005 that claims 1-12 and 18-22 are allowed is erroneous. Also, the Examiner stated that the allowance of claims 13-15 on page 2 of the Advisory Action should have indicated claims 13-17 are allowed. Accordingly, the status of the claims as is indicated in the first paragraph of this section III.

**IV. STATUS OF AMENDMENTS**

The amendments to claims 4-6 in the After Final Response dated December 23, 2004 have been entered as indicated by the Advisory Action.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

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Brief of Appellant*

Referring to independent claim 1, an exemplary method is shown in Fig. 3 and described at the specification page 7, lines 7+ according to one embodiment of the disclosure. Step 302 determines whether a printer error has been detected, and step 306 determines whether the same error occurred T times within the last X minutes. If so, steps 308, 310 disclose generation of exemplary error messages. Step 314 illustrates exemplary rebooting of a printer if the condition of step S306 is negative.

Referring to dependent claims 4-6, an error log is shown as reference 214 in the exemplary embodiment of Fig. 2. According to one embodiment described at page 6, lines 24+ of the specification, the error log 214 may include information such as the date and time of the printer error, the type of error, and the print job being processed at the time of the error.

Referring to dependent claim 7, exemplary aspects regarding reprinting a print job are described at page 9, lines 8+ of one embodiment of the originally filed specification.

Referring to independent claim 9, an exemplary method is shown in Fig. 3 and described at the specification page 7, lines 7+ according to one embodiment of the disclosure. Step 302 determines whether a printer error has been detected, and step 312 determines whether the same error occurred Y consecutive times. If so, steps 308, 310 disclose generation of exemplary error messages. Step 314 illustrates exemplary rebooting of a printer if the condition of step S312 is negative.

Referring to dependent claim 12, exemplary aspects regarding reprinting a print job are described at page 9, lines 8+ of one embodiment of the originally filed specification.

Referring to independent claim 18, exemplary printers 110, 112 are shown in Fig. 1 and described at page 4, lines 14+ according to one embodiment of the originally-filed specification. An error log is shown as reference 214 in the exemplary embodiment of Fig. 2. Details of error log 214 according to one embodiment are described at page 6, lines 24+ of the specification. An error analysis module is shown in one exemplary embodiment in Fig. 2 and described at page 6, lines 27+ of the originally-filed specification. Rebooting of the printer if a particular printer error has not occurred a predetermined number of times within a

predetermined time period is described in one embodiment in Fig. 3 at step 314 and the specification teachings at page 8, lines 1 + .

Referring to dependent claim 20, an error log is shown as reference 214 in the exemplary embodiment of Fig. 2. According to one embodiment described at page 6, lines 24+ of the specification, the error log 214 may include information such as the date and time of the printer error.

**VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL**

- A. The 103 rejection of claims 1-12 and 18-22 over the combination of Ulrich and Urano.
- B. The 103 rejection of claims 4, 6 and 20 over the combination of Ulrich and Urano.
- C. The 103 rejection of claims 1-12 and 18-22 over the combination of Ulrich and Urano.
- D. The 103 rejection of claims 1-8 over the combination of Ulrich and Urano.
- E. The 103 rejection of claims 9-12 over the combination of Ulrich and Urano.
- F. The 103 rejection of claims 18-22 over the combination of Ulrich and Urano.
- G. The 103 rejection of claims 7 and 12 over the combination of Ulrich and Urano.

## VII. ARGUMENT

- A. The 103 rejection of claims 1-12 and 18-22 is improper for lack of proper motivation to combine the teachings of Urano with the teachings of Ulrich.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed., rev. 2).

The legal concept of *prima facie* obviousness is a procedural tool of examination and allocates who has the burden of going forward with production of evidence in each step of the examination process. MPEP §2142 (8<sup>th</sup> Ed., revision no. 2). MPEP §§2142 and 2143 address this legal concept extensively. The *examiner bears the initial burden* of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to *provide some suggestion of the desirability of doing what the inventor has done*. MPEP §2142 (8<sup>th</sup> Ed., revision no. 2) (emphasis added). The alleged motivation presented by the Office fails to meet this burden.

On page 3 of the Final Office Action mailed November 4, 2004 (hereinafter the "Office Action" or "Action") with respect to claim 1, it is stated that U.S. Patent No. 5,208,814 to Ulrich does not explicitly disclose the use of a predetermined time period and thereafter looks to teachings of U.S. Patent No. 6,202,158 B1 to Urano to allegedly cure the deficiencies of Ulrich. Similar deficiencies of Ulrich with respect to independent claims 9 and 18 are noted on respective pages 5 and 6 of the Action and the teachings of Urano are relied upon as curing such deficiencies. Appellants respectfully submit there is no sufficient motivation to combine the two references in support of the 103 rejection of the pending claims and the Office has failed to establish a *prima facie* 103 rejection of claims 1-12 and 18-22.

At page 3 of the Action with respect to claim 1, the Examiner states that security logging generates large amounts of data and alerts and the volume of this



data may be overwhelming. The Examiner alleges that Urano discloses the use of predetermined time period to help organize this volume of data and the combination is obvious to incorporate the time periods of Urano into the printer error logging and repair system of Ulrich creating a more robust fault tolerant system. Similar positions are taken by the Office on pages 5 and 7 of the Action with respect to respective claims 9 and 18. Appellants respectfully assert the alleged motivation is deficient.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

In particular, the Office alleges on pages 3, 5 and 7 of the Action that security logging generates large amount of data and alerts. The Office states that this security logging is similar to error logging. The Office baldly alleges that this

volume of data often becomes "overwhelming." Appellants initially note that the Office has failed to identify any objective evidence (e.g., teachings of Ulrich) that the volume of data of the error logs is overwhelming. In fact, Appellants have electronically searched both Urano and Ulrich and have failed to find the term or any teachings referring to a "volume" of security or error logs. The Examiner refers to the teachings in col. 2, lines 1-9 of Urano in support of the need of data management of security failure data. However, Appellants note that the alleged problems identified by the Office are pertinent to problems of the system of Urano. The Office has failed to identify any teachings or other evidence that a person of skill concerned with the printer logs of Ulrich would be overwhelmed by data or concerned with solving problems regarding arrangement of security log information or otherwise motivated to look to other prior art for meaningful teachings. *There is no evidence of record that the system of Ulrich is overwhelmed by data or the system of Ulrich is otherwise concerned with having too much data.* To the contrary, and as discussed further below, Ulrich specifically discloses maintaining comprehensive records to identify specific individual corrupt print jobs (col. 7, lines 50-57). *Appellants submit one of skill in the art would not be motivated to combine the teachings of Urano with Ulrich when Ulrich does not have problems in the first instance which would allegedly be addressed or cured by the combination of reference teachings.*

Turning to the disclosure of Ulrich, Ulrich is concerned with entirely different problems than problems of being overwhelmed by a volume of data as alleged by the Office. There is no evidence of record that Ulrich's disclosed solutions to Ulrich's problems are defective or deficient to motivate one to look to other prior art teachings, let alone, security teachings of Urano which are only tenuously at best related to the problems of Ulrich concerned with identifying individual specific faulty printer jobs enabling an operator to delete them as set forth in col. 7, line 50 - col. 8, line 2 of Ulrich.

More specifically, referring to col. 1, lines 55+, Ulrich is concerned with identifying the number of times a fault occurs and the number of times that a system crashes along with a record of the jobs which are concurrently active at the time of the crash. This enables Ulrich to provide a solution by monitoring an entirety of the dataset to identify the specific jobs which cause crashes which were

unavailable in the prior art (col. 2, lines 40+). Ulrich discusses the need to log all faults and crashes and is not concerned with dividing the faults or crashes into different periods of time or other related management as alleged by the Office. In particular, at col. 7, line 50+, it is stated that system controller 7 includes a job summit counter which provides comprehensive recordation of all jobs which are active in the system, and the number of times that a job is active and the system crashed. By the modification to Ulrich proposed by the Office, the complexity of the system would be increased with no advantage towards the purpose of Ulrich.

In addition, there is no evidence that the disparate teachings of Urano regarding security logging may be successfully combined with the teachings of Ulrich to provide an operable system or that the resultant system would provide any benefit to Ulrich. Ulrich is concerned with printer *error logging* and not *security logging*. Ulrich specifically discloses monitoring all of the data in an attempt to identify individual defective print jobs. The dividing logs by time periods as proposed by the Office goes against the specific explicit teachings of Urano regarding usage of the comprehensive recordation of compiled data set to identify specific print jobs. In addition, the Ulrich system resulting from the combination proposed by the Office may miss some of the specific individual defective print job which it was designed to detect based upon the data being provided in separate groups. Accordingly, the combination proposed by the Office may frustrate or destroy the purpose of the invention of the Ulrich patent. *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (stating that a proposed modification is inappropriate for an obviousness inquiry when the modification renders the prior art inoperable for its intended purpose). Even if an operable system would result, the combination drastically increases the complexity of the Ulrich system without solving a problem which is of concern to Ulrich. Ulrich is not concerned with dividing the data by time periods (and the record is void of an objective reason to provide such capability to the system of Ulrich) but rather is directed to comprehensive recordation to identify individual faulty print jobs which is not facilitated by modifications proposed by the Office.

Perhaps even more compelling, a modification of Ulrich to arrive at the claim 1 invention which recites rebooting would require the system of Ulrich to perform reboot operations as a specific part of its operational plan or scheme. This result is

directly contrary to the specific disclosed operations of Ulrich. For example, Appellants respectfully refer to col. 2, lines 3+ of Ulrich stating that *rebooting is time consuming and significantly decreases the efficiency of the system*. At col. 8, lines 24+ of Ulrich, it is stated that if a corrupt job is found, the operator may be instructed to delete the job and permitted to resume processing of non-corrupted jobs with no mention of rebooting but rather to continue printing to provide increased efficiency. Modifying Ulrich to arrive at Appellants' claim 1 invention by providing reboot operations in the event that a predetermined error has not occurred a predetermined number of times as defined in claim 1 is contrary to the specific Ulrich teachings and accordingly such teach away from the combination proposed by the Office. Such teaching away is the *antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction*. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

In addition, Appellants submit that the statement that the incorporation of the time periods of Urano into the printer error logging and repair system of Ulrich creating a more robust fault tolerant system is insufficient with respect to the motivation requirement. How would the robustness of the system be increased? Which specific aspects of the system as disclosed by Ulrich would benefit or be improved by the proposed modification? Appellants submit that Ulrich has designed a presumably operable system which is directed towards the *particular problem addressed by Ulrich to identify individual faulty print jobs*. There is no evidence of record that the system of Ulrich is not sufficiently robust, that the robustness of the system would be increased if modified per Urano, nor that even if the system would have increased robustness, that such increase would be an advantage to motivate one of skill in the art to look to Urano for meaningful teachings.

Ulrich is not concerned with unauthorized access but with a specific purpose of furthering the printer error log teachings of the art to provide *identification of specific individual faulty print jobs*. Monitoring unauthorized attempts to access a computer system of Urano are unrelated to the Ulrich system and would not result in any improvement to the system of Ulrich designed for the purpose of identifying specific print jobs to motivate one to combine the prior art teachings.

The unsupported motivational rationale set forth in the present Office Action is akin to the alleged improper motivation discussed in *In re Lee* and accordingly is insufficient to combine the reference teachings. In particular, there is absolutely **no evidence of record to support the subjective conclusory statement of the Examiner that the resulting method or system would be a "more robust fault tolerant system" as baldly alleged.** In fact, the combination as proposed by the Office would frustrate the Ulrich system's ability to identify individual specific defective print job while increasing the complexity of the Ulrich system as set forth above. The only motivation presented in the Office Action is based upon **the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority.** There is no motivation to support the combination of references and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper.

Appellants submits that the alleged motivation presented by the Examiner would open the door to combinations of any art which would allegedly provide a "robust" system with absolutely no evidence or objective support apart from the bald, conclusory statements of the Examiner. **This is contrary to the authority of the Federal Circuit that motivation may not be based upon the subjective belief of the Examiner or unknown authority.**

The proposed modifications of Ulrich to allegedly arrive at the subject matter of Appellants' claims are irrelevant to the operations of the printer of Ulrich concerned with identifying and deleting individual specific faulty printer jobs. The motivation identified by the Office is not supported by objective evidence of record, but rather, to the contrary, the objective prior art teachings identified by Appellant teach away from the modifications proposed by the Office. The only motivation may be improperly based upon Appellants' disclosure in view of the lack of objective evidence to support the modification and the actual teaching away of the combination of prior art teachings as proposed by the Office. However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Appellants' invention as a road map for such combination. See, e.g., *Interconnect Planning Corp. v. Veil*, 227 USPQ 543, 551 (Fed. Cir. 1985)

For at least the above compelling reasons, the Office has failed to meet *their burden* of establishing proper motivation to combine the prior art teachings of Urano with Ulrich. The Office has failed to establish a proper *prima facie* 103 rejection for at least this reason and Appellants respectfully request allowance of claims 1-12 and 18-22.

**B. The 103 rejection of claims 4, 6 and 20 is improper for lack of proper motivation to combine the teachings of Urano with the teachings of Ulrich.**

On page 4 of the Action, the Office merely identifies teachings of Urano (Fig. 7 item 703) which allegedly disclose limitations of dependent claims 4 and 6 without recitation of any motivation as to why one would modify Ulrich using such identified teachings. The motivation alleged on page 3 of the Action was to provide a "more robust fault tolerant system." However, there is no objective evidence of record that the teachings of Fig. 7 of Urano related to providing of data, time and error type information would provide or are relevant to a system of increased robustness. Appellants submit that the Office has failed to meet their burden of factually supporting a *prima facie* conclusion of obviousness with respect to claims 4, 6 and 20. Appellants respectfully submit that the 103 rejection of claims 4, 6 and 20 is improper for at least this additional reason.

**C. The 103 rejection of claims 1-12 and 18-22 is improper inasmuch as there is no reasonable expectation of success if the teachings of Urano are combined with the teachings of Ulrich.**

Urano is concerned with providing information concerning inappropriate attempts to access a computer system entirely unrelated to the system of Ulrich concerned with problems of trying to identify individual specific faulty print jobs which may cause a printer to crash so an operator may delete the faulty print jobs. There is no expectation of success of a resultant system of the combination being more robust with respect to the objective of Ulrich of identifying the specific individual faulty print jobs since the teachings of Urano to be combined are not relevant to the problem of Ulrich in the first instance (i.e., identifying individual

faulty print-jobs). Appellants respectfully submit the Office has failed to establish a proper 103 rejection of claims 1-12 and 18-22 for this additional compelling reason.

**D. The 103 rejection of claims 1-8 is improper inasmuch as positively recited limitations of the claims are not taught by the prior art even if the teachings of Urano are combined with the teachings of Ulrich.**

The Office at page 3 of the Action identifies teachings in cols. 6 and 7 of Ulrich as allegedly disclosing the rebooting the printer depending upon whether the printer error has not occurred a predetermined number of times. Appellants assert such teachings fail to disclose the claimed limitations. The identified teachings of col. 6, lines 62-64 merely provide *examples of possible faults or crashes* and the teachings of col. 7, lines 11-13 are void of any rebooting teachings and merely refer to "recovery." The teachings relied upon by the Office of void of *rebooting the printer depending upon whether the printer error has not occurred a predetermined number of times* as specifically claimed.

In fact, Ulrich teaches away from the claimed method of claim 1 by explicitly stating that rebooting is to be avoided as mentioned above. Not only are specific limitations of claim 1 not disclosed by the combination of the teachings of the art proposed by the Office, the combination would violate specific contrary explicit teachings of Ulrich. The Ulrich teachings relied upon by the Office regarding rebooting evidence the faulty nature of the Office's position. The limitations of claim 1 reciting rebooting the printer responsive to the analysis of the number of times of an occurrence of a predetermined printer error are not taught by the prior art and claims 1-8 are allowable for this additional reason.

Further, the disparate teachings of Urano at col. 6, lines 1-6 relied upon by the Office regarding logon operations of a user are irrelevant to cause any rebooting and fail to cure the deficiencies of Ulrich. The identified teachings of Urano are relevant to detect improper access actions which even if such does or does not occur within a time period, it is not disclosed as resulting in a reboot. The mere usage of a time period in Urano fails to disclose or suggest the specific analysis of the occurrence of the printer error a predetermined number of times with respect to the predetermined time period or the rebooting recited in claim 1.

In addition, the combination of teachings of Urano with the teachings of Ulrich fails to disclose or suggest limitations of claims 1-8 regarding the predetermined time period and the 103 rejection is improper for this additional reason. Ulrich is concerned with providing a comprehensive record of printer errors and is not concerned with specifics of determining whether or not a printer error has occurred a predetermined number of times within a predetermined time period or taking plural different actions if the printer error occurred or not with such time period. Ulrich is concerned with providing the comprehensive record and not monitoring the occurrences of errors in a given time period since such is irrelevant to provision of a comprehensive list in an attempt to identify individual specific faulty print jobs. Further, the ambiguous teachings of Urano at col. 2, lines 1+ regarding the failure to use time intervals in the prior art precluding one from identifying errors concentrated within a specific time zone fail to cure the deficiencies of Ulrich relative to taking the claimed different courses of action (error message versus reboot) responsive to analysis of whether a printer error has occurred a predetermined number of times within the claimed predetermined time period.

In sum, Ulrich is directed towards a system of providing a comprehensive recordation of the number of times that a job is active and the system crashes in an attempt to identify specific individual faulty jobs for deletion by a user. Appellants have failed to uncover any teachings in Ulrich that the reference is concerned with taking different courses of action (one including rebooting) responsive to an analysis of whether a printer error has occurred a predetermined number of times. In addition, the teachings of Urano are irrelevant to any analysis of an occurrence of a printer error a predetermined number of times within a predetermined time period.

Positively recited limitations of the method of claim 1 are not disclosed nor suggested by the prior art even if the teachings of Urano are combined with the teachings of Ulrich and claims 1-8 are allowable for at least this compelling reason.



- E. The 103 rejection of claims 9-12 is improper inasmuch as positively recited limitations of the claims are not taught by the prior art even if the teachings of Urano are combined with the teachings of Ulrich.

Claims 9-12 specifically recite *rebooting the printer responsive to the nonoccurrence of a printer error a predetermined number of consecutive times*. Any modification to Ulrich to provide rebooting responsive to the defined nonoccurrence of the error recited in claim 9 is directly contrary to the aim of Ulrich to provide an efficient system which avoids reboots. Further, the teachings in cols. 6 and 7 of Ulrich relied upon by the Office as allegedly disclosing the claim rebooting merely state *examples of possible faults or crashes* or merely refer to "recovery" which fail to disclose the claimed conditions of the reboot.

Further, claim 9 recites monitoring for the occurrence of a *printer error for a predetermined number of consecutive times* and taking different courses of action in the presence or absence of the monitored occurrence. The number of consecutive times that an error occurs is irrelevant to Ulrich since Ulrich is concerned with providing a *comprehensive list* of errors and associating specific ones with crashes of the printer. The disparate teachings of Urano at col. 6, lines 61-67 regarding monitoring authentication of a user via password failures fails to cure the deficiencies of Ulrich regarding monitoring the occurrence of a printer error a predetermined number of consecutive times. Consecutive analysis may be concern in Urano to show a pattern of conduct by an unauthentic user trying to gain access to a computer at a moment in time by repeated failed attempts. However, the aim or concern for looking at consecutive events is not present or relevant in Ulrich as noted by the absence of such teachings or any explanation by the Office as to how monitoring for the existence of consecutive printer errors would achieve any more favorable results over the *compressive monitoring* of all printer errors already disclosed in Ulrich.

Monitoring the occurrence of a printer error a predetermined number of consecutive times is irrelevant to the disclosed aims and purposes of Ulrich and even if the prior art teachings are combined, the combination fails to disclose the claimed limitations.

Appellants have failed to uncover any teachings in Ulrich or Urano that the references are concerned with taking different courses of action (one including

rebooting) responsive to an analysis of whether a printer error has occurred a predetermined number of consecutive times.

Positively recited limitations of claim 9-12 are not disclosed nor suggested by the prior art even if the references are combined and Appellants respectfully submit that claims 9-12 are allowable for at least this reason.

**F. The 103 rejection of claims 18-22 is improper inasmuch as positively recited limitations of the claims are not taught by the prior art even if the teachings of Urano are combined with the teachings of Ulrich.**

Claims 18-22 recite a printer comprising an *error analysis module configured to reboot a printer if a particular printer error has **not** occurred a predetermined number of times within a predetermined time period.* The teachings of cols. 6 and 7 of Ulrich are alleged on page 6 of the Action to disclose a module configured to reboot a printer if a particular printer error has not occurred a predetermined number of times. The identified teachings of Ulrich merely refer to classes of errors or faults including those which cause reboots (col. 6), and that first attempts at recovery may be automatic (col. 7) and are void of the above-recited limitations of analyzing whether a particular printer error has occurred a predetermined number of times and rebooting if not. Ulrich teaches away from reboot operations to enhance the efficiency of the system disclosed in Ulrich. Ulrich discloses that once a specific individual print job has been identified it may be deleted and printing may occur with no mention of reboot to improve the efficiency of the system. The teachings of cols. 6 and 7 of Ulrich fail to teach or suggest the limitations of the error analysis module with respect to rebooting responsive to the printer error not occurring a predetermined number of times as alleged by the Office and accordingly limitations of claims 18-22 are not disclosed by the prior art even if the references are combined.

In addition, the teachings of Urano at col. 6, lines 1-6 regarding logon operations of a user are irrelevant to cause any rebooting and fail to cure the deficiencies of Ulrich. In particular, the identified teachings are relevant to detect improper access which even if such does or does not occur, is not disclosed as resulting in a reboot.

Limitations of claims 18-22 are not disclosed nor suggested by the prior art even if the reference teachings are combined and the rejection of claims 18-22 is improper for this additional reason.

**G. The 103 rejection of claims 7 and 12 is improper inasmuch as positively recited limitations of the claims are not taught by the prior art even if the teachings of Urano are combined with the teachings of Ulrich.**

Claims 7 and 12 recite *identifying a print job that was printing during the detected printer error and attempting to reprint the identified print job*. The teachings at col. 8, lines 3-28 of Ulrich relied upon by the Office specifically teach away from the limitations of claim 7. Ulrich is concerned with identifying individual corrupted print jobs which cause the system to crash, and once identified, the operator is instructed to delete the identified corrupted job at col. 8, lines 25-28. Ulrich teaches away from and fails to disclose or suggest the claimed *reprinting of an identified print job*.


Appellants respectfully submit that the prior art teachings relied upon by the Office fail to teach or suggest limitations of claims 7 and 12, and claims 7 and 12 are allowable for at least this reason.

**H. Conclusion**

In view of the foregoing, reversal of the final rejections of the claims 1-12 and 18-22 is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of claims 1-12 and 18-22.

Respectfully submitted,

Date: 5/3/05

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**VIII. APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL**

1           1. (Original) A method comprising:  
2           detecting a printer error;  
3           if the printer error has occurred a predetermined number of times within a  
4           predetermined time period, generating an error message; and  
5           if the printer error has not occurred a predetermined number of times  
6           within the predetermined time period, rebooting the printer.

1           2. (Original) A method as recited in claim 1 further comprising if the  
2           printer error has occurred a predetermined number of consecutive times,  
3           generating an error message.

1           3. (Original) A method as recited in claim 1 further comprising if the  
2           printer error has occurred a predetermined number of times within the  
3           predetermined time period, notifying a network administrator of the printer  
4           errors.

1           4. (Previously Presented) A method as recited in claim 8 wherein logging  
2           the printer error in an error log includes recording a date and time that the printer  
3           error occurred.

1           5. (Previously Presented) A method as recited in claim 8 wherein logging  
2           the printer error in an error log includes recording an identification of the print  
3           job being handled when the printer error occurred.

1           6. (Previously Presented) A method as recited in claim 8 wherein logging  
2           the printer error in an error log includes recording an error type associated with  
3           the printer error.

1           7. (Original) A method as recited in claim 1 wherein rebooting the printer  
2 further includes identifying a print job that was printing during the detected  
3 printer error and attempting to reprint the identified print job.

1           8. (Original) A method as recited in claim 1 further comprising logging  
2 the printer error in an error log.

1           9. (Original) A method comprising:  
2           detecting a printer error;  
3           logging the printer error in an error log;  
4           if the printer error has occurred a predetermined number of consecutive  
5 times, generating an error message; and  
6           if the printer error has not occurred a predetermined number of  
7 consecutive times, rebooting the printer.

1           10. (Original) A method as recited in claim 9 further comprising if the  
2 printer error has occurred a predetermined number of times within a  
3 predetermined time period, generating an error message.

1           11. (Original) A method as recited in claim 9 further comprising if the  
2 printer error has occurred a predetermined number of consecutive times,  
3 notifying a network administrator of the printer errors.

1           12. (Original) A method as recited in claim 9 wherein rebooting the  
2 printer further includes identifying a print job that was printing during the  
3 detected printer error and attempting to reprint the identified print job.

1           13. (Original) A method comprising:  
2           detecting a printer error;  
3           adding X points to a printer error counter;  
4           adding Y points to the printer error counter if the same printer error  
5 occurred within a predetermined time period;

6           determining whether the printer error counter exceeds a threshold value;  
7    and  
8           rebooting the printer if the printer error counter does not exceed the  
9    threshold value.

1           14. (Original) A method as recited in claim 13 further comprising  
2    notifying a network administrator of the printer errors if the printer error counter  
3    exceeds the threshold value.

1           15. (Original) A method as recited in claim 13 wherein rebooting the  
2    printer includes identifying a print job that was printing when the printer error  
3    was detected and attempting to reprint the identified print job.

1           16. (Original) A method as recited in claim 13 wherein the value of X  
2    varies depending on the type of printer error detected.

1           17. (Original) A method as recited in claim 13 wherein the value of Y  
2    varies depending on the type of printer error detected.

1           18. (Original) A printer comprising:  
2           a control panel configured to display information to a user of the printer;  
3           an error log configured to store information regarding printer errors  
4    detected by the printer;  
5           an error analysis module configured to analyze printer errors stored in the  
6    error log; and  
7           wherein the error analysis module is further configured to reboot the  
8    printer if a particular printer error has not occurred a predetermined number of  
9    times within a predetermined time period.

1           19. (Original) A printer as recited in claim 18 wherein the error analysis  
2 module is further configured to generate an error message on the control panel if  
3 a particular printer error has occurred twice within the predetermined time  
4 period.

1           20. (Original) A printer as recited in claim 18 wherein the error log  
2 stores a date and time that the printer error occurred.

1           21. (Original) A printer as recited in claim 18 wherein the error log  
2 stores an error type associated with the printer error.

1           22. (Original) A printer as recited in claim 18 wherein the error log  
2 stores information regarding the print job being processed when the printer error  
3 occurred.